

REMARKS

Claims 1-21, 23, 24, 26-30, 35-51, 53-63, and 66-69 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub. No. 2003/0050527 to Fox *et al.* (“Fox”).

In particular, the office action alleges that Fox discloses a conductor that is adapted to **reduce stimulation** induced by a magnetic stimulation device. (*Office Action dated January 25, 2008 at p. 4*). With all due respect to the contentions in the office action, applicant respectfully disagrees. Fox’s conductors do not reduce stimulation, but instead **create stimulation**.

The claimed embodiments are directed to a circuit pad that has a conductor adapted to reduce stimulation created by a magnetic stimulation device. The magnetic stimulation device creates magnetic fields, for example, to treat a patient’s depression.

In these embodiments, the magnetic stimulation device is placed near the patient’s head to stimulate the patient’s brain. Yet, these same magnetic fields that desirably treat the patient’s depression, may also undesirably stimulate other portions of the patient. For example, the magnetic fields may also cause undesirable and painful stimulation of the patient’s scalp. Obviously, such undesirable stimulation is not consistent with relieving the patient’s depression.

Fox does not teach or even suggest that its conductors reduce stimulation. Quite the contrary, Fox’s conductors specifically create the magnetic field that initiates such stimulation.

The office action suggests Fox’s Figures 12 and 13 teach copper windings that reduce stimulation. (*Office Action dated January 25, 2008 at p. 4*). However, throughout the discussion of Figures 12 and 13, Fox notes that the coils are designed with “wings” that create an electric field that travels through the windings in opposite directions. (*Fox – paragraph [0151]*). Fox’s electric fields create magnetic fields used, for example, in transcranial magnetic stimulation (TMS) of the brain. (*Fox – paragraph [0008]*). This use of the conductors to create magnetic fields is consistent with Fox’s expressed objective of providing coil designs to “provide an extremely focused field penetration” and thus allow TMS to be successful. (*Fox – paragraph [0013]-[0014]*).

Accordingly, with all due respect to the contentions in the office action, applicant respectfully requests withdrawal of the rejection of claims 1-21, 23, 24, 26-30, 35-51, 53-63, and 66-69 under 35 U.S.C. 102(e) over Fox.

Claims 22 and 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fox in view of U.S. Pub. No. 2001/0018547 to Mechlenburg *et al.* (“Mechlenburg”). Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Fox. Claims 31-34, 52 and 64-65 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fox in view of U.S. Patent No. 6,477,410 to Henley *et al.* (“Henley”).

For the same reasons discussed above with respect to the rejection of claims 1-21, 23, 24, 26-30, 35-51, 53-63 and 66-69 under 35 U.S.C. 102(e) over Fox, applicant respectfully requests withdrawal of the rejection of claims 22 and 63 over Fox and Mechlenburg, claim 25 over Fox, and claims 31-34, 52 and 64-65 over Fox and Henley.

Claims 1-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the office action suggests that there is not proper antecedent basis for the term “magnetic stimulation device.” Claim 1 has been amended to overcome the rejection under 35 U.S.C. 112, second paragraph. Accordingly, applicants respectfully request withdrawal of the rejection of claims 1-43 under 35 U.S.C. 112, second paragraph.

Claims 7-19 and 54-60 stand rejected under 35 U.S.C. 112, first paragraph, allegedly as failing to comply with the enablement requirement. In particular, the office action suggests that the “disposal mechanism . . . was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” (*Office Action dated January 25, 2008 at p. 3-4*). Similarly, the drawings are objected to under 37 CFR 1.83(a) for not showing the disposal mechanism. The office action contends that “there is no physical structure assigned to the mechanism.” (*Office Action dated January 25, 2008 at p. 9*) (emphasis added). With all due respect to the contentions in the office action, applicants respectfully disagree.

As previously noted, the disposal mechanism is described in detail in the specification, and particularly at paragraph [0034] of the present specification. Applicant respectfully asserts that this description is sufficient to enable one of ordinary skill in the art to make and/or use the disposal mechanism feature.

In particular, the present specification describes that “[f]lexible circuit pad 106 also may include electrical or physical disposal mechanisms that require a new flexible circuit pad to be used with each treatment.” (*Specification* – paragraph [0034]). The present specification also notes an alternative “disposal mechanism [that] may allow a certain flexible circuit pad a certain number of times and/or be used by a certain patient.” (*Id.*). One of the stated purposes of such a disposal mechanism may be to “prohibit undesirable re-usage of the flexible circuit pad 106, and therefore facilitate sanitary usage of flexible circuit pad 106 both for an individual patient and across numerous patients.” (*Id.*).

Applicant submits that this description is sufficient for one of ordinary skill in the art to make and/or use a disposal mechanism on the novel device.

Accordingly, applicant respectfully requests withdrawal of claims 7-19 and 54-60 under 35 U.S.C. 112, first paragraph, as well as the objection to the drawings under 37 CFR 1.83(a).

DOCKET NO.: NNI-0005
Application No.: 10/672,833
Office Action Dated: January 25, 2008

PATENT

Conclusion

In view of the foregoing, applicant respectfully submits that the claims are allowable and that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

Date: July 23, 2008

/Vincent J. Roccia/

Vincent J. Roccia
Registration No. 43,887

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439